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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIMITRI KANEVSKY and ALEXANDER ZLATSIN

Appeal 2009-000725
Application 09/584,810¹
Technology Center 2400

Decided: August 6, 2009

Before JAY P. LUCAS, CAROLYN D. THOMAS, and STEPHEN C. SIU,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed May, 31, 2000. The real party in interest is International Business Machines Corporation.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1-5 and 7-19 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claim 6 was cancelled. Claims 20 and 21 were merely objected to, but not rejected, in the Advisory Action mailed 3/9/2006. Thus, claims 20 and 21 will be treated as, and assumed to be, allowable.

Appellants' invention relates to a method and system for reformatting computer files formatted for use on different operating systems. (*See Spec.* 2, 1. 25 to 3, 1. 3.) In the words of the Appellants:

[A] person, who owns a Dell computer, may receive a program from a Macintosh user. The person can then go on the Internet, and the [server] automatically takes the program and transforms it into a compatible form. The program is then sent back to the person in a usable form. This process can be done with any type of file.

(*Spec.* 3, ll. 13-19.)

Claims 1 and 7 are exemplary:

1. A method for re-formatting computer files,
comprising the steps:

inputting a data file into a computer having a
specified operating system;

using said computer to determine if the data file is
compatible with the specified operating system;

if the data file is not compatible with the computer, said computer transmitting the data file over the Internet from said computer to a universal server; and

the universal server, transforming the data file into a format compatible with the specified operating system of the computer, and sending the transformed data file back to the computer.

7. A universal program conversion method, comprising the steps:

entering data into a computer;

said computer having a specified operating system and checking to determine whether the format of the data is compatible with the specified operating system (OS) in the computer;

if the format is not compatible, said computer sending the data from the computer over a network to a remote Universal Driver;

on the Universal Driver, reformatting the data into a format compatible to the specified OS;

after the reformatting step, sending the data to a universal formatting server, to be converted to a format suitable for the user;

if it is determined that the data are compatible with the operating system, then checking to determine whether it is necessary to reformat the data;

if the data do not need to be reformatted, processing the data as the user requests; and otherwise, sending the data to the universal server; and this server checking whether the data are executables;

if the data are executables, then checking the Universal Driver to determine whether the data can be formatted on the Universal Driver; if the data can be so formatted, then formatting the data at the Universal Driver; and then sending the formatted data to the user; if the data can not be formatted at the Universal Driver, then checking to determine if the source code exists on a storage of source code; if the source code exists, the Universal Driver then recompiling the data in a new OS, and the Universal Driver then sending the data to the user; checking for instructions to format data; after the checking step, formatting the data are formatted according to the instructions, and then sending the data to the user.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Shaffer	US 6,092,114	Jul. 18, 2000 (filed Apr. 17, 1998)
Probert, Jr.	US 6,549,918 B1	Apr. 15, 2003 (filed Sep. 21, 1998)
CERN Document Service, http://documents.cern.ch/Convert (last updated June 17, 1999)		

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1-5 and 8-19 stand rejected under 35 U.S.C. § 103(a) for being obvious over Shaffer, Probert, and CERN.

R2: Claim 7 stands rejected under 35 U.S.C. § 103(a) for being obvious over Probert and CERN.

Groups of Claims:

Claims will be discussed in the order of the rejections, with the first claim in each rejection being representative, unless otherwise indicated. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants contend that the claimed subject matter is not rendered obvious by Shaffer, Probert, and CERN because the claim limitations “using said computer to determine if the data file is compatible with the specified operating system,” “if the data file is not compatible with the computer, said computer transmitting the data file over the Internet from said computer to a universal server,” and “the universal server, transforming the data file into a format compatible with the specified operating system of the computer, and sending the transformed data file back to the computer” are not disclosed or suggested in the prior art . (App. Br. 13, middle and 14, top.) Moreover, Appellants contend that both Shaffer and Probert teach away from the claimed invention. (Reply Br. 4, top.) The Examiner contends that each of the claims is properly rejected. (Ans. 14, bottom.)

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejection.

ISSUES

The issues involve whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). More specifically, a first issue turns on whether the claim limitations “using said computer to determine if the data file is compatible with the specified operating system,” “if the data file is not compatible with the computer, said computer transmitting the data file over the Internet from said computer to a universal server,” and “the universal server, transforming the data file into a format compatible with the specified operating system of the computer, and sending the transformed data file back to the computer” are disclosed or suggested in Shaffer, Probert, and CERN. The second issue is whether the Probert or Shaffer references teach away from the claims, rather than render them obvious.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method for transforming computer files formatted for different operating systems to provide interoperability between those systems. (*See* Spec. 2, ll. 13-16.) The method involves inputting a data file into a client computer; using the client computer to determine if the file is compatible; if the file is not compatible, sending the file to a server for conversion purposes; converting the file; and returning the converted file to the computer client. (*See* claim 1 and Spec. 2, l. 26 to 3, l. 3.)

Shaffer

2. The Shaffer reference discloses performing a file format check at the target client device 14, 16, 18. (*See* col. 4, l. 66 to col. 5, l. 2.) Shaffer further discloses sending a data file to a remote server 26 for purposes of conversion when the target client device 14, 16, 18 cannot perform the necessary conversion to access the data file. (*See* col. 3, ll. 21-25 and Fig. 1.)

Probert

3. The Probert reference addresses problems associated with sharing files over a network with a person using a different operating system, or application, or even a different version of the same operating system. (*See* col. 1, ll. 60-67.) Probert's filter driver allows applications to open such files even though the underlying operating system is different. (*See* col. 4, ll. 26-28.) Probert further discloses that when an application attempts to read and write a file, the filter driver converts the file to appear in the expected format. (*See* col. 4, ll. 31-33.)

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 1322 (Fed. Cir. 1989), that “claims must be interpreted as broadly as their terms reasonably allow.”

This court has held in a number of decisions that a United States patent speaks for all it discloses as of its filing date, even when used in combination with other references. *In re Zenitz*, 333 F.2d 924, 925 (CCPA, 1964) (internal citations omitted).

Appellants have raised the issue of Shaffer and Probert teaching away from the claimed invention. Our guiding court has held, “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the ’198 application.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejections of Appellants’ claims under 35 U.S.C. § 103. The prima facie case is presented on pages 4 to 12 of the Examiner’s Answer. In opposition, Appellants present numerous arguments.

*Arguments with respect to the rejection
of claims 1-5 and 8-19
under 35 U.S.C. § 103 [R1]*

The first argument addresses the claim limitation “the universal server, transforming the data file into a format compatible with the specified

operating system of the computer, and sending the transformed data file back to the computer.” (*See* App. Br. 13, bottom.)

Appellants argue, “The express teaching of Probert, Jr. et al, thus, is to provide this conversion software on the computer, and not on a remote server.” (*Id.*)

Both Probert and Shaffer were cited by the Examiner for disclosing the claimed “transforming” step as recited in exemplary claim 1. (*See* Ans. 5, middle to 6, top.) Shaffer discloses that the remote server 26 (Appellants’ claimed universal server) converts a data file and returns the converted data file. (*See* col. 5, ll. 29-34.) Moreover, Probert explicitly discloses converting incompatible files (Appellants’ claimed “data file”) from different operating systems. (*See* FF#3.) Since Appellants’ claimed “transforming” step reads on the combination of Shaffer’s disclosure of converting data files at the remote server 26 (Appellants’ universal server) and Probert’s disclosure of a filter driver that converts files formatted for different operating systems, we find that Appellants’ argument is unpersuasive.

“[M]ere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the ’198 application.” (*See In re Fulton*, 391 F.3d at 1201.) Appellants argue that both Shaffer and Probert teach away from the claimed invention. (Reply Br. 4, top.) Citing Shaffer’s Abstract, Appellants argue: “Shaffer, et al expressly states that the invention is for ‘isolating personal computers and other client devices from the process of converting...’. Clearly, this teaches

away from using that computer to do more of the conversion process”
(*Id.*)

The Examiner points out in the Answer that Shaffer discloses file conversion performed at the local server. (*See* Ans. 5, top; Shaffer, col. 2, ll. 43-45.) We carefully reviewed Shaffer, noting that Shaffer’s second embodiment discloses file conversion at the target client device. (*See* col. 4, l. 66 to col. 5, l. 2.) Since Shaffer discloses file conversion at both the local server (*see* col. 2, ll. 43-45) and the target client device (*see* col. 4, l. 66 to col. 5, l. 2), we find unconvincing Appellants’ argument that Shaffer teaches away. (Reply Br. 4, top.)

Concerning Probert, Appellants argue: “[T]he intent or goal of Probert, Jr., et al. is to perform the [file conversion] ‘on the fly.’ This teaches that delays are undesirable. However, the present invention . . . introduces delays.” (*Id.*, middle)

Probert discloses “on-the-fly” conversion of files. (*See* Abstract.) In addition, Probert discloses “a filter driver on the server side may be all that is required, as it can provide format conversions on the client’s view of information prior to providing it to the client, and also can appropriately transform information provided by the client to the proper format for storage on the server.” (Col. 8, ll. 30-35.) Thus, a person of ordinary skill in the art would have understood that Probert discloses two alternatives, “on-the-fly” and “server-side” conversions. (*See* Abstract and col. 8, ll. 30-35.) Since the reference discloses both file-conversion methods, Probert does not teach away, as Appellants have argued above.

Next, Appellants argue that “Shaffer, et al. does not disclose that the computer, which has found the data file incompatible, sends the actual data file to the conversion server.” (App. Br. 14, top.)

Regarding Appellants’ claim limitation “said computer transmitting the data file over the Internet from said computer to a universal server,” the Examiner equates one of the target client devices 14, 16, 18 with Appellants’ claimed “computer.” (Ans. 11, top.)

We carefully considered the portion of Shaffer cited by the Examiner, and indeed the whole reference. According to Shaffer, when a file cannot be converted at the client device 14, 16, 18 or the local server 12, the local server 12 forwards the file to the remote server 26. (FF#2.) Regardless of its route, Shaffer’s file does travel from the client device 14, 16, 18 to the remote server 26. (*Id.*) That Shaffer’s file travels through an intermediary device (*i.e.*, local server 12) is not a persuasive argument since exemplary claim 1 does not specify that the claimed “data file” must be routed directly to the claimed “universal server.” Thus, reading the claims broadly but reasonably, *see In re Zletz*, cited above, Appellants’ claim limitation “said computer transmitting the data file over the Internet from said computer to a universal server” does read on Shaffer’s disclosure for forwarding a file via a local server. Accordingly, we find no error in the Examiner’s analysis.

Appellants further contend that the CERN reference does not disclose or suggest the claimed “determine” step as recited in exemplary claim 1. (App. Br. 14, middle.) Specifically, Appellants argue: “[CERN] does not disclose using the computer to determine that the file is not compatible with the computer’s operating system. Instead, with the CERN procedure, the computer user determines what files to send for conversion.” (*Id.*)

However, CERN is cited by the Examiner for disclosing “over the Internet,” as recited in exemplary claim 1 (*see* Ans. 6, top), and not for the claim limitation “using said computer to determine if the data file is compatible with the specified operating system,” as Appellants have argued above. (App. Br. 14, middle.) We thus concentrate on the combination of Shaffer and Probert for Appellants’ claimed “determine” step and the claim limitation “over the Internet.”

First, the Examiner finds that Shaffer discloses Appellants’ claimed “determine” step. (Ans. 5, top.) Shaffer discloses that “the determination of whether an attachment is accessible without conversion by a target device occurs at the server.” (Col. 2, ll. 43-45.) What is more, we note that Shaffer explicitly discloses file conversion at the target device where Shaffer states that “the format check and the capability comparison occurs at the target client device 14, 16, 18.” (Col. 4, l. 66 to col. 5, l. 1.)

Turning to Appellants’ claimed “over the Internet” limitation, Shaffer discloses not only the network 22 that the Examiner has cited, *see* Ans. 5, middle, but also an “Internet application of the system and method of exchanging” files that may require conversion. (Col. 4, ll. 12-13.) Thus, Shaffer’s disclosure of the Internet, and not merely a network, is explicit.

Moreover, the Probert reference discloses problems associated with sharing files over a network with a person using a different operating system, or application, or even a different version of the same operating system. (FF#3.) Probert’s filter driver allows applications to open such files even though the underlying operating system is different. (*Id.*) Probert further discloses that when an application attempts to read and write a file, the filter driver converts the file to appear in the expected format. (*Id.*)

Accordingly, Probert specifically discloses converting files formatted for use on different operating systems. (*See* FF#3.) Since Appellants' claimed "determine" step and "over the Internet" are disclosed by the combination of Shaffer and Probert, we find unpersuasive Appellants' argument regarding what CERN fails to disclose.

*Argument with respect to the rejection
of claim 7
under 35 U.S.C. § 103 [R2]*

Appellants argue "the prior art does not disclose or suggest using a computer, first, to determine if a file is compatible with the computer's operating system, and second, using that same computer to transmit the data file over a network to a remote Universal Driver for conversion to a suitable format, as described in independent Claim 7." (App. Br. 15, middle.)

As we stated above, Shaffer's path from the target client device 14, 16, 18 via the intermediary point (*i.e.*, local server 12) is not relevant since Appellants' claim 1 fails to require that the file take a direct route. (*See* claim 1.) The data is transmitted to a remote Driver, albeit indirectly. Thus, we find Appellants' argument unpersuasive.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-5 and 8-19 under 35 U.S.C. § 103(a) as specified in [R1] and rejecting claim 7 under 35 U.S.C. § 103(a) as specified in [R2].

DECISION

The Examiner's rejection [R1] of claims 1-5 and 8-19 under 35 U.S.C. § 103(a) for being obvious over Shaffer, Probert, and CERN is Affirmed.

The Examiner's rejection [R2] of claim 7 under 35 U.S.C. § 103(a) for being obvious over Probert and CERN is Affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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